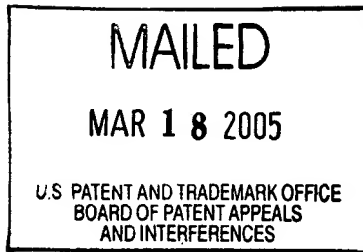


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte CHERYL B. LEBEAU
and SHERRY L. TILLMAN

Appeal No. 2005-0485
Application No. 09/303,632

ON BRIEF

Before FRANKFORT, MCQUADE and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Cheryl B. Lebeau et al. appeal from the final rejection of claims 21 through 26, 28 through 30, 32 through 37, 41 and 42. Claims 27, 31 and 38, the only other claims pending in the application, stand objected to as depending from rejected base claims.

THE INVENTION

The invention relates to "disposable covers for keyboards used with computers in dental and medical fields to maintain the keyboards' sterility" (specification, page 1). Representative claims 21 and 32 read as follows:

21. A package of individual disposable transparent covers of a predetermined size in length and width for protecting the sterility of a keyboard of a computer, each said cover comprising at least one flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout and a predetermined size in length and width to contact and protect an entire upper surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner.

32. An individual disposable transparent cover having a predetermined size in length and width for protecting the sterility of a keyboard of a computer, comprising a flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout and a predetermined size in length and width to contact and overlies an entire upper surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator of a keyboard while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Okamura	5,089,690	Feb. 18, 1992
Gaible et al. (Gaible)	5,397,182	Mar. 14, 1995
Adair	5,812,188	Sep. 22, 1998
Yanagisawa	5,872,527	Feb. 16, 1999

Appeal No. 2005-0485
Application No. 09/303,632

Young, British
Patent Document

2,201,922

Sep. 14, 1988

"Conformal Cover for a Handheld Computer Unit," IBM Technical Disclosure Bulletin, Vol. 37, No. 6B, pp. 125-126, June 1994 (IBM)

THE REJECTIONS

Claims 32, 35 through 37, 41 and 42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gaible.

Claims 32 and 35 through 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanagisawa in view of Adair.

Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanagisawa in view of Adair and either Okamura or Young.

Claims 21 and 24 through 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanagisawa in view of Adair and IBM.

Claims 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanagisawa in view of Adair, IBM and either Okamura or Young.

Claims 21, 24 through 26 and 28 through 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaible in view of IBM.

Attention is directed to the main and reply briefs (filed April 29, 2004 and October 18, 2004) and the answer (mailed

August 11, 2004) for the respective positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 32, 35 through 37, 41 and 42 as being anticipated by Gaible

Gaible discloses "a container such as a clear flexible bag 30 formed with a pair of [extruded] plastic side walls 32a and 32b which may be heat-sealed together along their edges 33a, 33b to define a container interior 34 having an open end 36" (column 4, lines 34 through 38). The container also includes an interlocking closure device comprising first and second closure strips 218 and 220 heat-sealed to respective upper edge portions 37 of the side walls 32a and 32b.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713

Appeal No. 2005-0485
Application No. 09/303,632

F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied,
465 U.S. 1026 (1984).

The appellants' position that the rejection of claims 32, 35 through 37, 41 and 42 is unsound because independent claims 32 and 41 contain a number of limitations not met by Gaible is unpersuasive. Each of Gaible's flexible, clear, extruded plastic sidewalls 32a and 32b comprises a flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout as recited in claim 32, and collectively these sidewalls comprise two identical flat entirely transparent planar sheets of pliable plastic film as recited in claim 41. Notwithstanding the appellants' argument to the contrary, each sidewall embodies a "film" under the ordinary and accustomed meaning of this term. For example, Webster's New World Dictionary of the American Language, Second College Edition (The World Publishing Company 1972) defines "film" as "a fine, thin skin, surface, layer, or coating." This definition clearly encompasses Gaible's sidewalls 32a and 32b. Also, since claims 32 and 41 are open "comprising" claims, they do not exclude the closure strips 218 and 220 secured to Gaible's sidewalls.¹

¹ When a claim uses an "open" transition phrase, such as "comprising," its scope may cover devices that employ additional unrecited elements. AFG Industries Inc. v. Cardinal IG Co., 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001).

Furthermore, the appellants have not cogently explained why Gaible's sidewalls do not have a predetermined size in length and width to either contact and overlies an entire upper surface of a computer keyboard as recited in claim 32 or protect an entire upper and bottom surface of a keyboard as recited in claim 41 so as to inhibit unintentional contact between the keyboard and fingers of an operator while not impeding an operator's ability to manipulate the keyboard in a speedy and accurate manner. Computer keyboards come in many shapes and sizes, and it is not apparent why Gaible's sidewalls would not be inherently capable of meeting the foregoing size and use limitations in claims 32 and 41 with respect to the keyboard of a small hand-held calculator/computer.²

Hence, the appellants' position that the subject matter recited in independent claims 32 and 41, and dependent claims 35 through 37 and 42, distinguishes over that disclosed by Gaible is not well taken. Therefore, we shall sustain the standing 35 U.S.C. § 102(b) rejection of these claims as being anticipated by Gaible.

² A calculator is considered to be a particular type of computer by those of ordinary skill in the art. In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

II. The 35 U.S.C. § 103(a) rejection of claims 32 and 35 through 37 as being unpatentable over Yanagisawa in view of Adair

Yanagisawa discloses a protective cover for a medical keyboard. The cover 34, 34' comprises a thin, transparent, waterproof member having an elastic fixing part 34a, e.g., a rubber band, for enclosing part (Figure 9) or all (Figure 10) of a keyboard upper surface during use to prevent contamination by medical by-products.

As conceded by the examiner, Yanagisawa does not meet the limitation in independent claim 32 requiring the cover to be "plastic."

The appellants, referring to the encompassing recitation of "a flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout," allow that while "Yanagisawa teaches a flat sheet that requires rubber bands to be used to secure it to a portion or all of a keyboard" (main brief, pages 5 and 6), the reference is additionally deficient with respect to claim 32, and more particularly the foregoing recitation in the claim, because it

employs a rubber band in the embodiments of FIGS. 9 and 10. Moreover, the cover 34 works in conjunction with a "partition member" 32 to which the rubber band is attached to secure the cover 34 or 34'. Accordingly, it is not even clear that the cover of Yanagisawa would stay in place on the keyboard or a portion thereof without the rubber bands [main brief, page 5].

The appellants' position here is not well taken. As pointed out above, claim 32 is an open "comprising" claim and thus does not exclude the presence of other elements such as Yanagisawa's rubber band.

As for the admitted failure of Yanagisawa to meet the "plastic" limitation in claim 32, Adair discloses a sterile enclosure 12a for a laptop computer 60 (see Figure 5) used in surgical environments. The enclosure comprises a substantially transparent, flexible and liquid/gas impermeable plastic such as polyurethane, polyolefins, laminated plastic films or the like forming a body having an open end that may be sealed by tape or adhesive 18a.

The examiner's conclusion that Adair would have suggested making Yanagisawa's cover of plastic is well founded, with the requisite motivation found in Adair's description of various plastics as having properties, e.g., transparency, flexibility and liquid/gas impermeability, manifestly suitable for Yanagisawa's objective of preventing keyboard contamination.

Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 32 as being unpatentable over Yanagisawa in view of Adair.

We also shall sustain standing 35 U.S.C. § 103(a) rejection of dependent claims 35 and 36 as being unpatentable over

Yanagisawa in view of Adair since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 32 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

Claim 37 depends ultimately from claim 32 and requires the sheet to be formed as an envelope with an elongated opening along an elongated top edge portion. Adair's laptop computer enclosure embodies such a construction, and the examiner's conclusion that it would have been obvious in view of same to form Yanagisawa's cover with a like construction to allow the keyboard to be used in a sterile environment is well taken.

Therefore, we shall sustain standing 35 U.S.C. § 103(a) rejection of claim 37 as being unpatentable over Yanagisawa in view of Adair.

III. The 35 U.S.C. § 103(a) rejection of claims 33 and 34 as being unpatentable over Yanagisawa in view of Adair and either Okamura or Young

Claim 33 depends from independent claim 32 and requires the sheet to have a strip of adhesive along its top edge portion for attachment to a keyboard. Claim 34 depends from claim 32 and requires the sheet to have a pair of spaced strips of adhesive

along its top and bottom edge portions for attachment to a keyboard. Conceding that Yanagisawa lacks these features, the examiner turns to either Okamura or Young.

Okamura discloses a molded plastic keyboard overlay 30 secured in place by upper and lower adhesive layers or strips 44 and 48, and Young discloses a clear, flexible, protective keyboard cover secured in place with adhesive tape. Either of these disclosures would have provided the artisan with ample suggestion to replace Yanagisawa's elastic fixing part with upper and/or lower adhesive strips as a simple matter of substituting one art-recognized keyboard cover securing alternative with another.

Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 33 and 34 as being unpatentable over Yanagisawa in view of Adair and either Okamura or Young.

IV. The 35 U.S.C. § 103(a) rejection of claims 21 and 24 through 26 as being unpatentable over Yanagisawa in view of Adair and IBM

The examiner concedes that Yanagisawa does not meet the limitations in independent claim 21 requiring (1) a "package" of individual disposable transparent covers and (2) each of the covers to comprise a film which is "plastic." The appellants' contention that Yanagisawa also fails to meet the claim limitation requiring a flat planar sheet of uniform thickness

throughout due to the presence of Yanagisawa's elastic fixing part 34a is not persuasive for the reasons expressed above.

The examiner's reliance on Adair as suggesting the use of plastic to make Yanagisawa's film is well taken for the reasons set forth above. As for the "package" limitation in the claim, the examiner cites IBM for (1) its disclosure of a clear plastic cover which can be applied to a handheld computer unit to protect it from inclement weather and (2) its teaching that the covers may be sold in packs to facilitate discarding and replacing them when soiled or damaged. The appellants do not specifically dispute the examiner's conclusion that it would have been obvious in view of IBM to provide a plurality of the Yanagisawa covers as modified in view of Adair in a package to facilitate discarding and replacing the covers as they become soiled or damaged.

Consequently, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 21 as being unpatentable over Yanagisawa in view of Adair and IBM.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 24 through 26 as being unpatentable over Yanagisawa in view of Adair and IBM since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 21 (see In re Nielson, supra).

Appeal No. 2005-0485
Application No. 09/303,632

V. The 35 U.S.C. § 103(a) rejection of claims 22 and 23 as being unpatentable over Yanagisawa in view of Adair, IBM and either Okamura or Young

Claims 22 and 23 depend from claim 21 and recite adhesive strip limitations similar to those discussed above in conjunction with claims 33 and 34. The examiner's application of either Okamura or Young to meet these limitations is well founded for the reasons expressed above.

Hence, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 22 and 23 as being unpatentable over Yanagisawa in view of Adair, IBM and either Okamura or Young.

VI. The 35 U.S.C. § 103(a) rejection of claims 21, 24 through 26 and 28 through 30 as being unpatentable over Gaible in view of IBM

For the reasons discussed above, Gaible meets all of the limitations in independent claim 21 except for the one requiring a "package" of individual disposable transparent covers. The appellants do not specifically dispute the examiner's conclusion that it would have been obvious in view of IBM to provide a plurality of the Gaible bags in a package to facilitate discarding and replacing them when soiled or damaged.

Appeal No. 2005-0485
Application No. 09/303,632

Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 21 as being unpatentable over Gaible in view of IBM.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 24 through 26 and 28 through 30 as being unpatentable over Gaible in view of IBM since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with independent claim 21 (see In re Nielson, supra).

SUMMARY


The decision of the examiner to reject claims 21 through 26, 28 through 30, 32 through 37, 41 and 42 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).


Appeal No. 2005-0485
Application No. 09/303,632

AFFIRMED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES


JEFFREY V. NASE
Administrative Patent Judge

JPM/gjh

Appeal No. 2005-0485
Application No. 09/303,632

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